

## **REMARKS**

### **STATUS OF APPLICATION**

No claims have been canceled, no claims have been amended, and no new claims have been added. Accordingly, claims 1-46 are pending in the present application.

### **DRAWINGS**

The indication, that the drawings filed on August 14, 2001 are accepted by the Examiner, is acknowledged with appreciation.

To date, no Notice of Draftsperson's Patent Drawing Review has been received. Applicants respectfully request receipt of this document when it becomes available. Please note that the original drawings filed in the patent application are "formal" drawings.

### **ALLOWABLE SUBJECT MATTER**

The allowance of claims 31-39 by the Examiner is noted with appreciation. Further, the indication that claims 2, 8-30, 41, and 45 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim is also acknowledged with appreciation. These claims, however, have not been so rewritten at this time, as Applicants believe the independent claims from which they depend are in condition for allowance.

### **35 USC § 112 REJECTION**

The rejection of claim 4 under 35 USC § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter that Applicants regard as their invention, is respectfully traversed. Claim 4 has been amended to overcome the rejection. Accordingly, it is

respectfully requested that the rejection of claim 4 under 35 USC § 112, second paragraph, be reconsidered and withdrawn.

### 35 USC § 102 REJECTION

**Claims 1, 3-7, 40, 42-44 and 46 are allowable over US 5,465,786**

The rejection of claims 1, 3-7, 40, 42-44, and 46 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,465,786 to Akkerman (hereinafter referred to as "the Akkerman patent"), is respectfully traversed for the reasons set forth below.

Claim 1 requires, *inter alia*, a valve member and a sliding sleeve movable between an upper position and a lower position and having a seating element on which the valve member can seat. The Akkerman patent teaches that the flapper valve 35 engages a seat on a downward tubular extension of the lower guide body 28.<sup>1</sup> The lower guide body 28 is held in a fixed vertical position, and thus is not the claimed sliding sleeve.<sup>2</sup> The Office Action alleges that the flow tube 40 of the Akkerman patent is the claimed sliding sleeve. However, the Akkerman patent teaches that the flow tube 40 is either spaced just above the flapper 35 or with its lower end engaged with the flapper 35. The Akkerman patent does not, however, teach that the flow tube 40 is sealingly engaged with the flapper 35. Rather, the Akkerman patent teaches that the flow tube 40 engages the flapper 35 merely to open the flapper 35.<sup>3</sup>

Thus, the lower guide body 28 cannot be construed as the claimed sliding sleeve, because it does not move vertically. The flow tube 40 cannot be construed as the claimed sliding sleeve, because it does not include a seating element on which the flapper 35 can seat. Rather, the

<sup>1</sup> See column 5, lines 54-58, of the Akkerman patent.

<sup>2</sup> See column 5, lines 42-43, of the Akkerman patent.

<sup>3</sup> See column 6, lines 50-55, of the Akkerman patent.

flapper 35 engages a seat on the downward tubular extension of the lower guide body 28, which cannot move vertically. Claim 1 is anticipated by the Akkerman patent, "[o]nly if each and every element as set forth in the claim is found, either expressly or inherently described" in a single prior art reference."<sup>4</sup> Further, "[t]he identical invention must be shown in as complete detail as is contained in the...claim."<sup>5</sup> The Akkerman patent, however, falls short of these requirements.

Further, the Akkerman patent does not render the present invention, as set forth in claim 1, obvious. The Akkerman patent fails to suggest, or even suggest the desirability of, having a seating element on the flow tube 40 on which the flapper 35 can seat. In fact, the Akkerman patent teaches that the lower end of the flow tube 40 can be spaced just above the flapper 35. Thus, the Akkerman patent fails to provide any motivation for one skilled in the art to move the seal from the lower guide body 28 to the flow tube 40. Thus, the Akkerman patent fails to render the present invention, as set forth in claim 1, obvious.

Claims 3-7 depend from claim 1. Accordingly, the remarks provided *supra* concerning claim 1 apply equally to claims 3-7.

Claim 40 requires, *inter alia*, selectively locking the flapper valve in the closed position and selectively releasing the flapper valve to the open position. Instead, the Akkerman patent teaches that the flapper 35 is merely urged closed by a torsion spring 45 and the flow tube is adapted to be lowered so as to overcome the torsion of the spring 45 and other forces (*i.e.*, hydraulic back pressure within the well bore) tending to maintain the flapper 35 closed.<sup>6</sup> The

<sup>4</sup> See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

<sup>5</sup> See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

<sup>6</sup> See column 5, line 67, through column 6, line 6, of the Akkerman patent.

Office Action alleges that the Akkerman patent discloses the use of keys 88 to permit the flapper 35 to maintain a desired position. The Akkerman patent, however, teaches that the keys 88 are lowered onto the shoulder 90 to move the lower end of the flow tube 40 downwardly into engagement with the top side of the flapper 35. Thus, the keys 88 are merely used to control the downward motion of the flow tube 40 to engage the flapper 35 and urge it open. The keys 88 do not selectively lock the flapper 35 in the closed position, or selectively release the flapper valve 35 to the open position, as required by claim 40. Rather, the flapper 35 can be opened by merely overcoming the force applied thereto by the torsion spring 45. Thus, the flapper 35 is not locked. Accordingly, the Akkerman patent does not anticipate the present invention, as set forth in claim 40.

Further, the Akkerman patent fails to provide any motivation for one skilled in the art to modify the method of operation thereof to include locking the flapper 35. Rather, the Akkerman patent is silent with regard to even the desirability of locking the flapper 35. Accordingly, the Akkerman patent cannot render the present invention, as set forth in claim 40, obvious.

Claims 42-44 and 46 depend from claim 40. Accordingly, the remarks provided *supra* concerning claim 40 apply equally to claims 42-44 and 46.

Accordingly, it is respectfully requested that the rejection of claims 1, 3-7, 40, 42-44, and 46 under 35 U.S.C. § 102(b), as being anticipated by the Akkerman patent, be reconsidered and withdrawn.

#### **PROVISIONAL DOUBLE PATENTING REJECTION**

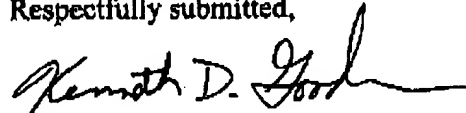
The provisional rejection of claims 1, 2, 5, 6, 8, 9, 11-14, and 16-19 is noted and will be taken up at a later time.

**CONCLUSION**

Attached hereto is an appendix including a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

Wherefore, in view of the foregoing remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited. The Examiner is invited to contact Daren C. Davis at (817) 578-8616 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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## APPENDIX

### VERSION WITH MARKINGS TO SHOW CHANGES MADE

The following is a marked-up version of the changes to the specification and claims that are being made in the attached response to the Office Action dated December 4, 2002.

#### IN THE CLAIMS:

Claim 4 is amended as follows:

4. (Once Amended) The apparatus of claim 3, wherein the valve member comprises a flapper type valve hinged on one side and a torsion spring member that urges the valve member towards a location between the open position and the closed position; wherein when the sliding sleeve is in the upper position, the torsion spring member urges the valve member to seat onto the seating element; and wherein when the sliding sleeve is between the upper position and the lower position and the contact surface is not in contact with the valve member, the torsion spring member urges the valve member to be located between the open position and the closed position and to protrude into the longitudinal [bore of the second segment.] bore.

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<b>No. of Pages:</b> 9	<b>Date:</b> March 4, 2003
<b>Re:</b> Response to Office Action	<b>File:</b> 2032.006196
<b>Serial No.</b> 09/929,499	

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